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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,620	01/30/2006	Matthias Winkel	ZAHFRI815US	7373
20210 7590 05/27/2008 DAVIS BUJOLD & Daniels, P.L.L.C. 112 PLEASANT STREET CONCORD, NH 03301				
EXAMINER				
LE, DAVID D				
ART UNIT		PAPER NUMBER		
3681				
MAIL DATE		DELIVERY MODE		
05/27/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/566,620

**Applicant(s)**

WINKEL ET AL.

**Examiner**

David D. Le

**Art Unit**

3681

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-893)  
Paper No(s)/Mail Date 01/30/06
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This is the first Office action on the merits of Application No. 10/566,620, filed on 30 January 2006. Claims 12-22 are pending.

### **Documents**

2. The following documents have been received and filed as part of the patent application:
  - Copy of Foreign Priority Document, received on 01/30/06
  - Information Disclosure Statement, received on 01/30/06

### ***Information Disclosure Statement***

3. The information disclosure statement filed on 30 January 2006 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document. Accordingly, the listing EP-1 134 111 A2 reference, which was submitted without a legible copy, has not been considered.

### ***Claim Rejections - 35 USC § 112***

4. **The following is a quotation of the first paragraph of 35 U.S.C. 112:**

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 12-22 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the method of operating an automatic transmission as disclosed in paragraphs [016] to [031], does not reasonably provide enablement for the claimed method as

recited in claims 12-22. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Claim 12 specifically recites the method steps of:

- “Carrying out a downshifting during a compression braking operation which continues up to attainment of a predetermined threshold speed and terminated by engagement of a clutch located between a vehicle drive motor and the transmission, and
- When the downshifting is at a speed less than the predetermined threshold speed, terminating the downshifting by disengagement of the clutch.”

The present specification does not support the termination of the downshifting with an engagement of the clutch and a disengagement of the clutch, as recited in the present claim 12.

**6. The following is a quotation of the second paragraph of 35 U.S.C. 112:**

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 12-22 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Claim 12:**

Claim 12 recites the method step of:

- “Carrying out a downshifting during a compression braking operation which continues up to attainment of a predetermined threshold speed and terminated by engagement of a clutch located between a vehicle drive motor and the transmission, and
- When the downshifting is at a speed less than the predetermined threshold speed, terminating the downshifting by disengagement of the clutch.”

It appears that the method steps are contradicting each other.

Claim 15:

- Line 5 recites the limitation "the vehicle steering mechanism". There is insufficient antecedent basis for this limitation in the claim.

Claim 20:

- Line 3 recites the limitation "the compression phase". There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**9. Claims 12-22, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by U. S. Patent No. 6,497,635 to Suzuki (hereinafter referred to as Suzuki).**

*Claims 12-22:*

Suzuki (Figs. 1-4; column 2, line 65 – column 9, line 61) discloses a vehicle transmission control apparatus comprising a control unit for carrying out a downshifting during a compression braking operation which continues up to attainment of a predetermined threshold speed and by engagement of a clutch located between an engine and a transmission, and when the downshifting is at a speed less than the predetermined threshold speed, terminating the downshifting by disengagement of the clutch.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Onimaru et al. (U. S. Patent No. 5,842,952) teaches a control device for releasing an exhaust brake and engaging a lockup clutch simultaneously during a down shift.
- Matsumoto et al. (U. S. Patent No. 5,161,432) teaches an engine brake control system for automatic power transmission.
- Iizuka (U. S. Patent No. 5,069,085) teaches a shift control system for automatic power transmission.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David D. Le whose telephone number is 571-272-7092. The examiner can normally be reached on Mon-Fri (0900-1730).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A. Marmor can be reached on 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David D. Le/  
Primary Examiner, Art Unit 3681  
05/22/2008

ddl